

## **REMARKS**

### **I. Status of the Application**

In view of the above amendments and the following remarks, reconsideration of the rejections and objections set forth in the Office Action of January 15, 2010 is respectfully requested.

By this amendment, claim 6 has been amended, claims 1-5 and 7-56 have been cancelled without prejudice or disclaimer to the subject matter contained therein, and claims 57-67 have been added. Claims 6 and 57-67 are now pending in the application. No new matter has been added by these amendments.

The specification has been reviewed and revised, and the amendments to the specification have been incorporated into the substitute specification attached herewith. For the Examiner's benefit, a marked-up copy of the specification indicating the changes made thereto is also enclosed. No new matter has been added by these revisions. Entry of the substitute specification is respectfully requested.

### **II. Drawings**

On page 2 of the Office Action, the drawings are objected to regarding several informalities. Replacement sheets in compliance with 37 C.F.R. § 1.121(d) are submitted herewith to correct these informalities; no new matter has been added. The drawings now fully comply with the requirements of 37 C.F.R. § 1.84, and thus withdrawal of these objections is respectfully requested.

### III. Specification

On page 4 of the Office Action, the specification is objected to regarding a minor informality. This issue has been corrected by the aforementioned amendments to the specification; withdrawal of this objection is thus respectfully requested.

### IV. 35 U.S.C. § 112

On pages 5 and 6 of the Office Action, claims 6-12, 53, and 54 are rejected as being indefinite.

Regarding claim 6, Applicants note that the meaning of the term “relative density” is set forth in the specification at least on page 29. As such, it is submitted that claim 6 is clear and definite when read in light of the specification. See MPEP 2111. Withdrawal of this rejection is thus respectfully requested.

The rejections of claims 7 and 54 are moot in view of the cancellation of those claims. Moreover, Applicants note that new claim 57 includes limitations similar to those previously recited in claim 7, except that claim 57 more clearly establishes that a process of forming the sintered compact is described. Additionally, new claim 64 includes limitations similar to those previously recited in claim 54, except that proper antecedent basis is provided for the recitation “bronze allow phase.”

Further, it is submitted that each of claims 6 and 57-67 is clear and definite.

### V. Prior Art Rejections

Currently, claims 6, 12, and 53 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Takeshi (JP 08-109450), claim 7 stands rejected under 35 U.S.C. § 103(a) as

being unpatentable over Takeshi, and claims 8, 9-11, and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Takeshi in view of various other prior art references.

It is submitted that the present invention, as defined in the amended claims, is now clearly distinguished over the applied prior art for the following reasons. Claim 6 recites a sliding member comprising: a back metal; and a sintered sliding body combined with the back metal, wherein said sintered sliding body is composed of a sintered compact containing Cu or Cu alloy in an amount of 10 to 95wt% and a residue made of Mo principally, wherein said sintered compact has a relative density of at least 80%, and wherein said sintered compact contains Mo in an amount of 35 to 75wt%.

On pages 7 and 8 of the Office Action, in addressing claim 7, the Examiner acknowledges that the Takeshi reference does not disclose the sintered compact containing Mo in an amount of 35 to 75wt%. However, it is asserted that this configuration would have been obvious in view of the *In re Aller* precedent. MPEP 2144.05 discusses the standards for making a determination of obviousness as to the optimization of numerical ranges, citing the *In re Aller* precedent. That section of the MPEP clearly provides that (1) an assertion of obviousness is not supported by the disclosure of “general conditions” in the prior art when the claim limitation at issue is critical to the invention<sup>1</sup>, and (2) only variables which have been recognized in the prior art as being result-effective can be optimized<sup>2</sup>.

As discussed throughout the specification, the Mo content recited in amended claim 6 is critical to the present invention, and thus the assertion that the Takeshi reference discloses the

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<sup>1</sup> “Generally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical.” MPEP 2144.05, emphasis added

<sup>2</sup> “A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” MPEP 2144.05.

“general conditions” of the claim does not support a determination of obviousness. Specifically, as discussed at least on pages 93, 101, and 105-106 of the specification, the claimed Mo content of 35 to 75wt% allows for a component having the optimum thermal expansion coefficient, thereby providing a component which exhibits conformability during sliding under high-bearing stress and high-speed sliding conditions as well as excellent seizing resistance and abrasion resistance. Accordingly, because the claim limitation at issue is critical to the present invention, no prima facie case of obviousness has been established with respect to the subject matter of amended claim 6.

Moreover, the obviousness rejection of claim 7 set forth in the Office Action does not contain any assertion or evidence indicating that the content of Mo in a sintered compact of a sliding member is recognized in the prior art as being a result-effective variable. As such, there is nothing to suggest that one of ordinary in the art would modify the apparatus of Takeshi to yield the claimed invention, and thus no prima facie case of obviousness has been established with respect to amended claim 6.

The remaining prior art of record is relied on for alleged disclosures which are unrelated to the above-discussed deficiencies of Takeshi, and Applicants submit that these references also fail to disclose the above-discussed requirements of claim 6.

Further, it appears as though there would have been no reason to modify any of the prior art of record to yield a configuration which would meet the requirements of claim 6. It is thus submitted that the invention of the present application, as defined in claim 6, is not anticipated nor rendered obvious by the prior art, and yields significant advantages over the prior art. Allowance is respectfully requested.

Claims 57-67 depend, directly or indirectly, from claim 6 and are thus allowable for at least the reasons set forth above in support of claim 6.

In view of the foregoing amendments and remarks, inasmuch as all of the outstanding issues have been addressed, it is respectfully submitted that the present application is now in condition for allowance, and action to such effect is earnestly solicited. Should any issues remain after consideration of the response, however, the Examiner is invited to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,

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